

REMARKS

Claims 1-21 were examined in the official action of October 24, 2005. Applicant appreciates the indication that claims 4, 8, and 15-19 would be allowable if rewritten to include all limitations of the base claim and any intervening claims. Claim 6 stands rejected for indefiniteness, and claims 1-3, 5-7, 9-14, 20 and 21 stand rejected for obviousness. Applicant respectfully traverses the rejection for the reasons stated herein. Reconsideration is respectfully requested.

Claims 22-25 have been added. Claim 22 recites that the guide means include first and second posts. Support can be found, for example, on page 3, lines 25-27 and Fig. 1.

Enclosed herewith is an IDS citing English translations of the three references applied against the claims of this application as well as copies of the translations. Because this response is after the first office action on the merits, and applicant had knowledge of these English-language references for more than three months, applicant submits the fee of \$180.

Claims 1-25 are at issue, with six independent claims. Enclosed is our check of \$2000 to cover the filing fee for three independent claims in excess of the three previously paid for, four total claims over the 21 previously paid for, the three month extension of time, and the IDS.

This response is timely filed, as it is accompanied by a petition for a three month extension of time, the requisite extension fee, and is filed within the third month of extension.

The issues raised in the official action will be addressed in the order that they appeared in the action.

Interview Summary.

The applicants appreciate the Examiner taking the time to discuss the pending office action with the applicant and his representatives on April 4, 2006. As indicated in the interview summary, the Examiner agreed to reconsider the rejection based on the arguments presented at the interview and to review the arguments and declaration once officially presented. By way of this filing, the arguments and declaration are officially presented.

Claim 6 is Not Indefinite

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The official action notes that “said tip member” lacks antecedent basis and should instead recite “said unitary member.” Claim 6 has been amended as suggested by the examiner. Reconsideration and withdrawal of the indefiniteness rejection is therefore requested.

Claims 1-3, 5-7, 9-14, 20 and 21 are Not Obvious

Applicant respectfully traverses the rejection of claims 1-3, 5-7, 9-14, 20 and 21 under 35 U.S.C. § 103(a) as obvious over Omori, Japanese Patent No. JP-63-56690 (“Omori”) in view of de Ruyter, French Patent No. 2643351 (“de Ruyter”). Claim 1 recites a correction tape dispenser including, in part, guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape. Applicant respectfully traverses the rejection to claim 1, at least because the addition of the features taught in de Ruyter to the correction tape dispenser disclosed in Omori to achieve the subject matter of claim 1 would in fact destroy the

functionality of Omori's correction tape dispenser. See MPEP § 2143.01(V). Accordingly, the examiner has not made out a *prima facie* case of obviousness.¹

Omori discloses a correction tape dispenser 10 with a supply reel 30 and a take-up reel 40 and an applicator tip 20. A tape 11 extends from the supply reel 30, over the outside of a first peg 18, around the applicator tip 20, over the outside of a second peg 19, and back to the take-up reel 40. The first peg 18 and the second peg 19 are spaced a considerable distance from each other such that the tape 11 makes an approximately 45° bend at the edge 25 of the applicator tip 20. As can be seen in Fig. 3, the applicator tip 20 includes guide flanges 23, 24 that define channels 23a, 24a. The guide flanges 23, 24 maintain the tape 11 within the channels 23a, 24a. The Omori device does not include any structure that twists the tape at any point along its length.

de Ruyter discloses an adhesive tape dispenser. The dispenser includes an applicator tip edge that is oriented perpendicularly to the axis of rotation of the tape roll, and accordingly, the tape undergoes a 90° twist along its length from the roll to the edge.

The official action asserts that "it would have been obvious to modify the correction tape dispenser [of Omori] by providing the tip perpendicular to the axis of the supply spool so that the tape undergoes twist [sic] of 90° from the spool to the tip edge, as taught by [de Ruyter]."

Applicant respectfully traverses this assertion, because rotating the applicator tip of Omori as asserted by the examiner would destroy the functionality of the correction tape dispenser. As can be seen in Fig. 1 of Omori, the path of the tape 11 around the applicator tip 20 forms an angle of approximately 45°. As more fully described in the attached Declaration of Bret Marschand and Attached Drawings, the alleged modification to Omori would require the

¹ Claim 1 has been slightly amended solely for clarity.

tape to make a sharp bend into the guide channel 23a while the tape is flat. As can be seen in Fig. A1, this sharp bend would make the tape drag on the corner of the flange 23 and buckle as it turned into the channel 23a. This buckling would make the tape 11 ragged, and the correction tape would be pulled off the backing tape by the flanges 23, and thus would be very unappealing to the consumer. Even further, upon use of the modified correction tape dispenser, the tape would fold over itself along its length as shown in Fig. A2 of the attached drawings. Within the industry, this is considered a failure.

Accordingly, there is no suggestion in the references themselves to combine de Ruyter with Omori, and claims 1-3, 5-7, 9-14, 20 and 21 are allowable over the cited references.

Claims 4, 8, 15, and 16-19 are Allowable

The official action indicates that dependent claims 4, 8, 15, and 16 would be allowable if rewritten in independent form to include all limitations of the base claim and any intervening claims. The noted claims have been amended as suggested by the examiner. Accordingly, claims 4, 8, 15, and 16 are allowable. Claims 17-19, which depend from claim 16, are also allowable.

Claims 22-25 are Allowable

Claims 22-25 are allowable for all the same reasons that claim 1 is allowable, and for the further reason that the combination of Omori and Ruyter fails to disclose all elements claimed. Specifically, independent claim 22 recites a correction tape dispenser including, in part, guide means as recited in claim 1, wherein the guide means include a first post and a second post.

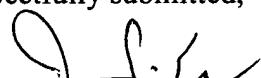
The only posts disclosed in Omori are the posts 18 and 19. However, the posts of Omori do not operate in conjunction with the shape of the tip so that the path of the tape around the edge is in a plane substantially perpendicular to the edge. Instead, the posts 18, 19 of Omori deliver and retrieve the tape relative to the head at an angle of approximately 45°. Therefore, in the asserted combination of Omori and de Ruyter, the post 18 delivers the tape to the head at an approximately 22 ½° angle to a plane that is perpendicular to the tip edge, and not in the plane as claimed. This angle caused by the post 18 creates the failure noted above, and therefore the post 18 does not work in conjunction with the shape of the tip to twist the tape as claimed. See Fig. A2. de Ruyter fails to disclose any posts at all. Accordingly, claims 22-25 are allowable over the art of record.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance. The fee for a petition for a three-month extension of time, three extra independent claims, four extra total claims, and an IDS is included herewith. If any further fee is due, please charge our Deposit Account No. 13-2855, under Order No. 29617/PM421A from which the undersigned is authorized to draw.

April 7, 2006

Respectfully submitted,

By 
James P. Zeller, Reg. No. 28,491
MARSHALL, GERSTEIN & BORUN LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant